

### **REMARKS**

The Office Action of June 7, 2004 has been carefully reviewed and this paper is Applicant's response thereto. Applicant respectfully requests reconsideration of the Application in view of the foregoing Amendments and the following remarks.

Claims 1-31 are pending. Claims 1, 9, 12 and 20 are amended. Claims 1-4, 9-15 and 20-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,729,917 to Slepian ("Slepian"). Claims 1-5, 7, 9-16, 18 and 20-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,220,737 to Edington ("Edington"). Claims 1-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,279,051 to Whatley ("Whatley"). Claims 23-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Whatley in view of U.S. Patent No. 4,219,945 to Rudy ("Rudy"). Claims 1-31 were rejected under the judicially created doctrine of nonstatutory double patenting.

### **Amendment to the Claims**

Claims 1 and 12 have been amended to correct informalities and to clarify the construction of the footwear. Claims 9 and 20 have been also amended to correct informalities. No new matter has been added, nor have the scope of these claims been changed by this amendment. It is respectfully submitted that all pending claims are in condition for allowance and notification of the same is earnestly requested.

### **Terminal Disclaimer**

Claims 1-31 were rejected under the judicially created doctrine of nonstatutory double patenting. Applicant encloses herewith a terminal disclaimer filed in compliance with 37 CFR 1.321(c). Therefore, withdrawal of this ground of rejection is respectfully requested.

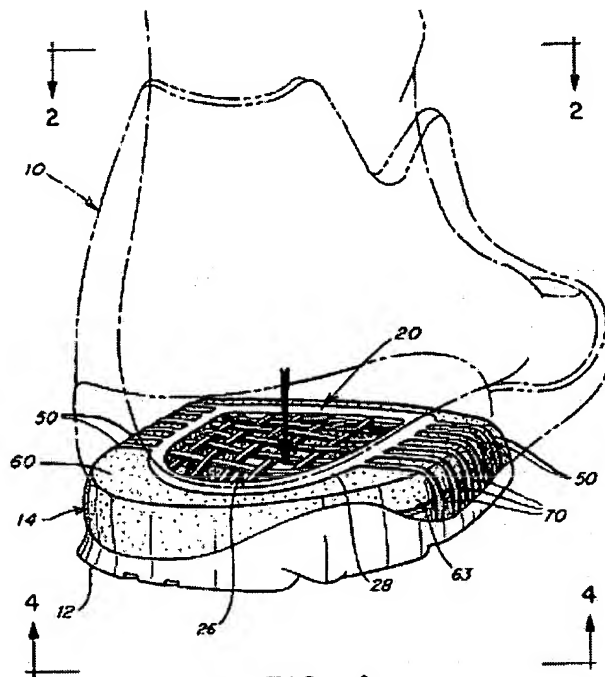
Serial No. 10/688,847

Response to Office Action dated June 7, 2004

**Rejection under 35 U.S.C. § 102(b) – Slepian**

Claims 1-4, 9-15 and 20-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by Slepian.

Slepian is directed toward an article of footwear that includes an outsole 12, and upper 10 and a midsole 14. (Slepian, Figure 1 – provided below).



**FIG. 1**

Slepian includes an energy return cassette 20 that comprises a net region 26 and a frame region or perimeter 28. (Slepian, C3, L46-51). The figures of Slepian plainly show that the frame region 28 is along the top surface of the midsole 14 and does not extend along the side of the midsole 14. Also, Slepian fails to disclose the use of a cushioning device. Thus, Slepian fails to disclose, for example, “the reinforcing rim extending from the base along the side wall of the cushioning device,” and fails to disclose the use of a “cushioning device” as recited in claims 1 and 12.

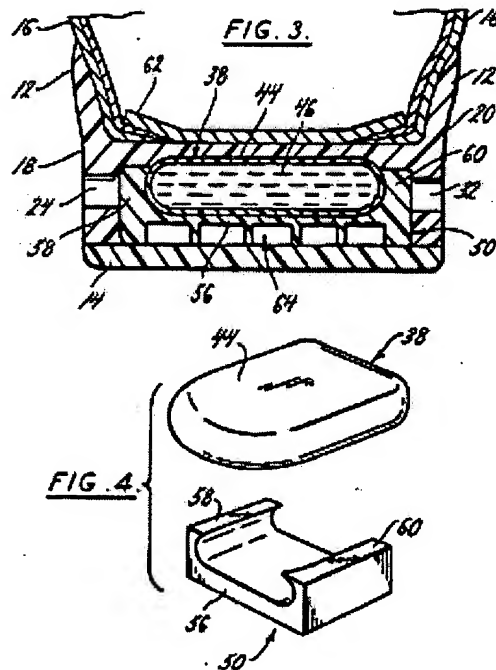
Therefore, Slepian fails to teach, suggest or disclose all the limitations of independent claims 1 and 12 and thus fails to anticipate those claims. All claims depending from claims 1 and 12 are therefore not anticipated by Slepian for the same reasons and for the additional

limitations recited in those claims. Accordingly, withdrawal of this ground of rejection is respectfully requested.

**Rejection under 35 U.S.C. § 102(b) – Edington**

Claims 1-5, 7, 9-16, 18 and 20-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Edington.

Edington is directed toward an article of footwear including an outsole 14, a midsole 18, upper 16, a fluid filled pad 38, and a stabilizer 50. Figures 3 and 4 of Edington are provided below:



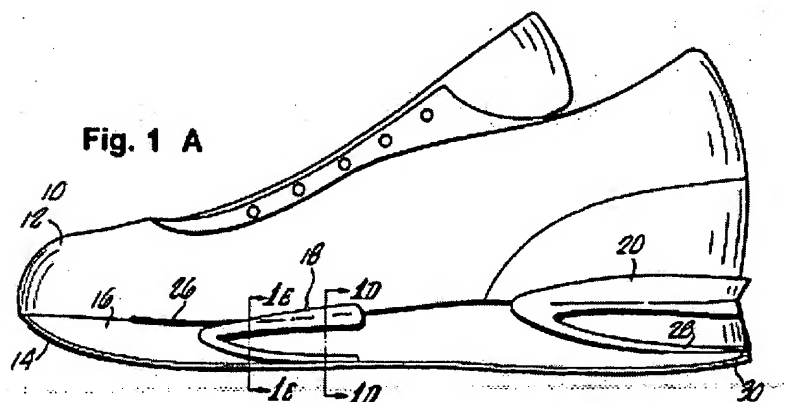
The stabilizer 50 includes support walls 58 and 60 that extend up from the base member 56. (Edington, C4, L55-56). As is clear in Figure 3, the support walls of Edington do not extend from the bottom of the pad to the top of the pad, as recited in the pending application. Nor is there any reason for the stabilizer support walls to extend from the bottom to the top of the pad because the pad 38 is encapsulated inside the midsole. Additionally, the pad 38 is not visible to an observer because the support walls 58 and 60 are solid and cannot be seen through, and the pad 38 and stabilizer 50 are encapsulated in the midsole.

Edington therefore fails to disclose the recited “plurality of ribs extending outwardly from the base and along the side wall of the cushioning device from the first surface to the second surface of the cushioning device” of independent claims 1 and 12. Thus, claims 1 and 12, and all depending claims, are not anticipated by Edington. Accordingly, withdrawal of this ground of rejection is respectfully requested.

Claim 23 recites “the bladder being visible through the spaced apart support members.” As noted above, the support walls 58 and 60 of Edington do not permit the fluid filled pad 38 to be seen by an observer. Similarly, the pad 38 is encapsulated inside the midsole and thus is not visible. Edington therefore fails to disclose “the bladder being visible through the spaced apart support members” and thus does not anticipate claim 23. Claims 24-27 are not anticipated by Edington for the same reasons and for the additional limitations recited in those claims. Accordingly, withdrawal of this ground of rejection is respectfully requested.

#### **Rejection under 35 U.S.C. § 102(b) - Whatley**

Claims 1-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by Whatley. Whatley states that it includes an article of footwear having an upper, an outsole and a midsole positioned between the upper and outsole. (Whatley, Abstract). Whatley states that an external spring is provided on the side of the article of footwear. (Whatley, C. 2, L. 19-36). For example, as shown in Figure 1A of Whatley (shown below), an external heel spring 20 is attached to the side of the shoe.



The Office Action appears to suggest that element 30 is representative of the recited “base,” and that element 20 is representative of the recited “rim.” For sake of argument, as evident from Figure 1A (as well as the other figures of Whatley), the alleged base 30 and alleged rim 20 do not structurally cooperate with each other as recited in the pending claims. That is, the alleged base 30 and alleged rim 20 are separated from each other and therefore the alleged rim 20 does not extend from the alleged base 30. In other words, Whatley does not teach the recited “reinforcing rim extending from the base along the side wall of the cushioning device.” In addition, Whatley does not disclose the use of a cushioning device. Moreover, the present invention is directed to protecting and supporting the cushioning device, while Whatley states that it is directed to providing an external spring located on the outside of a shoe. For these reasons, among others, Whatley does not anticipate claims 1 and 12.

Therefore, the Applicant respectfully submits that claims 1 and 12 are not anticipated by Whatley. All depending claims are allowable for the same reasons and for the recitation of the additional limitations in those claims. Withdrawal of this ground of rejection is respectfully requested.

**Rejection under 35 U.S.C. § 103(a) - Whatley**

Claims 23-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Whatley in view of Rudy.

Whatley is discussed above. In addition to the above description, Whatley also fails to teach, suggest or disclose the use of a “bladder” or “the plurality of spaced apart support members extending outwardly from the reinforcing rib, along the side wall of the bladder, and around the periphery of the bladder.”

Rudy states that it is directed to an article of footwear having an inflatable insert encapsulated in a foam cover for use as a midsole. (Rudy, C4, L31-33). The inflatable insert is used to absorb energy exerted upon the midsole during use of the footwear. (C5, L49-54). To ensure the insert is long lasting, Rudy allegedly teaches to fill the insert with a large molecule gas and to use an air-permeable foam to surround the insert, the foam being impermeable to the large molecule gas so that air tends to migrate into the insert, thereby keeping the insert fully inflated. (Rudy, C4, L4-30).

Thus, the combination of Whatley and Rudy would still not include the claimed "plurality of spaced apart support members extending outwardly from the reinforcing rib, along the side wall of the bladder, and around the periphery of the bladder" because the inflatable insert of Rudy is encapsulated in foam so the external springs of Whatley would not be "extending ... around the periphery of the bladder" as recited in claim 23. Also, Whatley is not directed to protecting and supporting a bladder. Thus, the combination of Whatley and Rudy fails to suggest, teach or disclose all the limitations of claim 23. See MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basis criterion must be met. ... [Third], the prior art reference[s] ... must teach or suggest all the claim limitations"). Therefore, it is respectfully submitted that claims 23-28 are non-obvious over Whatley in view of Rudy. Accordingly, the Applicant respectfully requests withdrawal of this ground of rejection.

### CONCLUSION

It is believed that a one-month extension fee is required for this submission. If any additional fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Applicant respectfully submits that all grounds for rejection having been addressed, the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,

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Dated: September 28, 2004

By:



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